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REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Claims 1-122 are presented for examination.

Various claims were rejected under 35 USC 102 as anticipated by Walker et al. application (20040039639). Other claims were rejected under 35 USC 103 over Walker in view of Examiner Notice. These rejections of the claims are traversed and reconsideration is respectfully requested.

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

The Walker et al. (20040039639) application filed on August 18, 2003 claims priority to a continuation of application serial no. 09/349,860 that has a filing date of July 9, 1999. As the Examiner noted, the chain to this earlier application was broken due to a failure to file a Petition for an Extension of Time in the 09/349,860 application, so that the (20040039639) application filed on August 18, 2003 was not entitled to the priority of serial no. 09/349,860. The requirement that was violated for the then-pending parent application is a statutory requirement that cannot be waived.

It is noted from PAIR that an Abandonment for Failure to Respond to Office Action was mailed to Applicant on November 17, 2003. After more than a two year delay, a Petition to Revive based on the relaxed standard of unintentional delay for 09/349,860 was entered on December 9, 2005. The Petition to Revive was granted on December 29, 2005 and the Examiner included a copy of the DECISION ON PETITION in his office action.

The alleged revival, if it is valid, is not retroactive for patent-defeating purposes. See *Urologix, Inc. v. Frostalund AB*, 256 F. Supp. 2d 911 (Dis. Ct E.D. Wis. 2003), copy attached. That case held that in an ongoing proceeding, wherein the initial decision on abandonment was correct, that it will not be revisited for that proceeding. The alleged revival, if valid, is not patent-defeating for the application of another applicant that was pending during the abandoned period, particularly for a revival based on unintentional delay. Such revival only fixes the chain of priority for purposes of maintaining the validity of the Walker application against prior art in this period. There is no patent-defeating retroactivity provided by the statute which authorizes revival for failure to respond to an office action based on unintentional delay. 35 USC 41 (a)(7) reads as follows:

> (7) On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed response by the patent owner in any reexamination proceeding, $1,210, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be $110.

Compare 35 USC 41 (c)(1) and (2) relating to revival for late payment of maintenance fees up to 24 months after the six-month grace period has lapsed. Congress intended a retroactive effect for this revival under Section 41 by stating in the statute "the patent shall be considered as not having expired at the end of the grace period," and explicitly provided for intervening rights. See 35 USC 41(c)(2). No such language authorizing intervening rights is found for petitions to revive a pending application for failure to respond within the statutory time period based on relaxed "unintentional delay." Thus, the grant of a petition of revival can result in a valid patent, but has no adverse patent-defeating effect against applications co-pending at the time.

Additionally, a two year delay after the Notice of Abandonment for Failure to Respond to Office Action was mailed to Applicant on November 17, 2003 cannot be considered either unintentional or unavoidable.

Since the present Landesmann application is entitled to a priority date of October 30, 2000, reconsideration and withdrawal of this rejection is respectfully requested. Note that during the period when there was a break in the chain of priority, the Walker (20040039639) application is not prior art to the present application, which was filed shortly after the Walker parent 1999 filing date and it cannot be converted to patent-defeating prior art retroactively. Accordingly, the Walker publication is not patent-defeating prior art relative to the present application.

Please note that Walker does not disclose the making of deposits, or the cancellation thereof.

All remarks are without prejudice to related applications, and nothing in this filing should be construed as an admission that the Walker US 2004/0039639 A1 application discloses any claimed elements unless stated otherwise.

It is unclear whether the examiner is making an indirect 101 rejection, in view of Office Action paragraph 10. Applicant believes that he has complied with this requirement in view of the addition of the "processor" and "memory" elements to claim 62.

Regarding Office Action paragraph 12 and the patentable weight to be given to the terms "third party" and "third party source," the examiner states that no patentable weight will be given for ownership. However, these limitation do not relate to ownership, Rather, such claims relate to specific actions or hardware in the claimed configuration. For example, dependent claim 4 recites "obtaining non-purchase information about the buyer entity from a third party." This claimed step relates to a receiving step, i.e., bringing in information from outside the system, with the protocols and other requirements that must be met in order to make that happen. Likewise, with respect to claim 6, the element is recited "wherein said receiving proof of purchase step comprises linking to a third party database and obtaining information there from on whether the buyer entity made a purchase of the good or service in the declaration." This operation relates to an actual link outside the system and meeting the requirements and protocols for such a link to be effective. Accordingly, weight must be given to such limitations.

Atty. Dkt. No. 084561-0106

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date October 5, 2006

By _____

FOLEY & LARDNER LLP
Washington Harbour
3000 K Street NW, Suite 500
Washington, D.C. 20007-5143
Telephone: (202) 672-5485
Facsimile: (202) 672-5399

William T. Ellis
Attorney for Applicant
Registration No. 26,874

PAGE 30/42 * RCVD AT 10/5/2006 5:06:33 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/18 * DNIS:2738300 * CSID: * DURATION (mm-ss):13-32

Exhibit A

Westlaw.
256 F.Supp.2d 911
256 F.Supp.2d 911
(Cite as: 256 F.Supp.2d 911)

H
Briefs and Other Related Documents

United States District Court,E.D. Wisconsin.
UROLOGIX, INC., Plaintiff,
v.
PROSTALUND AB, Prostalund Operations AB, and Circon Corporation, a/k/a ACMI Corporation, Defendants.
No. 02-C-0318.

April 7, 2003.

Owner of patent for surgical instrument, suing competitors for infringement, moved for reconsideration of order finding that patent was invalid, 227 F.Supp.2d 1033. The District Court, Adelman, J., held that reconsideration was not warranted.

Motion denied.

West Headnotes

[1] Courts 106 ⚿99(1)

106 Courts
106II Establishment, Organization, and Procedure
106II(G) Rules of Decision
106k99 Previous Decisions in Same Case as Law of the Case
106k99(1) k. In General. Most Cited Cases
Although court may reconsider its interlocutory orders at any time before entry of judgment, law of case doctrine counsels court in general to not reopen issues once decided. Fed.Rules Civ.Proc.Rule 54(b), 28 U.S.C.A.

[2] Federal Civil Procedure 170A ⚿928

170A Federal Civil Procedure
170AVII Pleadings and Motions
170AVII(I) Motions in General
170Ak928 k. Determination. Most Cited Cases
Although court will reconsider order in exceptional circumstance where its prior decision is clearly erroneous and would work manifest injustice, parties are expected to marshal all their arguments and evidence in opposition to dispositive motions, and court views belated factual or legal attacks with great suspicion. Fed.Rules Civ.Proc.Rule 54(b), 28 U.S.C.A.

[3] Patents 291 ⚿110

291 Patents
291IV Applications and Proceedings Thereon
291k110 k. Renewal of Application. Most Cited Cases

Patents 291 ⚿323.3

291 Patents
291XII Infringement
291XII(C) Suits in Equity
291k323 Final Judgment or Decree
291k323.3 k. Relief from Judgment or Decree. Most Cited Cases
Reconsideration of order finding patent invalid, on ground that application's lack of co-pendency deprived it of abandoned parent application's filing date, leaving it anticipated by prior art, was not warranted absent showing of clear error or manifest injustice; Patent and Trademark Office's subsequent revival of parent application was not retroactively effective, and patentee's failure to obtain earlier revival was intentional litigation strategy. Fed.Rules Civ.Proc.Rule 54(b), 28 U.S.C.A.; 35 U.S.C.A. § § 41(a)(7), 102, 120.

Patents 291 ⚿328(2)

291 Patents
291XIII Decisions on the Validity, Construction, and Infringement of Particular Patents
291k328 Patents Enumerated
291k328(2) k. Original Utility. Most Cited Cases
5,234,004. Invalid.

*912 A. Sidney KATZ, Chicago, IL, James Volling, Minneapolis, MN, Robert Briesblatt, Chicago, IL, for Plaintiff.
Kathleen Donius, Milwaukee, WI, Doris Johnson Hines, Washington, DC, Willem Schuurman, Austin, TX, Christopher Banaszak, Milwaukee, WI, Stephen Hash, Austin, TX, for Defendants.

DECISION AND ORDER

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ADELMAN, District Judge.
On October 10, 2002, I granted defendants' motion for summary judgment and held that plaintiff Urologix's U.S. Patent No. 5,234,004 (the " '004 patent") is invalid under 35 U.S.C. § 102(d). *Urologix, Inc. v. Prostalund AB*, 227 F.Supp.2d 1033 (E.D.Wis.2002). Urologix has now filed a motion pursuant to Fed.R.Civ.P. 54(b) requesting that I vacate my prior order.[FN1]

FN1. Both parties filed additional briefs with motions requesting that I consider them. I have done so and, therefore, will grant the parties' motions. (R. 150, 155.)

I. BACKGROUND

To explain my ruling on Urologix's motion to vacate, I must recount some of the history of the prosecution of the '004 patent. This history appears in more detail in my October 10, 2002 decision ("October 2002 decision").

In my October 2002 decision, I found the '004 patent invalid under 35 U.S.C. § 102(d) because the application that matured into the '004 patent, application serial No. 667,847 (the " '847 application"), and its parent application, serial No. 438,741 (the " '741 application"), were not copending. When the '741 application was filed, the applicants claimed a priority filing date under 35 U.S.C. § 120 based on an earlier-filed French application (the "French application"). On November 21, 1990, the United States Patent and Trademark Office ("PTO") issued an Office Action in the '741 application requiring a response from applicants within a three-month period. No response was filed; thus, the '741 application became abandoned.

After abandonment, the applicants filed the '847 application as a continuation-in-part of the '741 application. The '847 application also claimed a priority filing date under 35 U.S.C. § 120 based on the French application. However, because the '741 application was abandoned before the '847 application was filed, copendency between the '741 application and the '847 application did not exist. Hence, priority could not be claimed based on the French application.[FN2] The French application, therefore, became invalidating prior art under section 102(d).

FN2. For an application to receive the benefit of an earlier effective filing date under 35 U.S.C. § 120, it must be "filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application" *See* 35 U.S.C. § 120.

This issue of copendency was raised in a prior action in this district when the '004 patent was owned by Technomed Medical Systems, Inc. ("Technomed"). *See Technomed Med. Sys., Inc. v. Dornier Med. Sys., Inc.*, No. 98-C-345, slip op. at *2 *913 (E.D.Wis. Jul. 17, 1998) (Clevert, J.) (hereinafter, "*Technomed* "). Technomed was represented by the same attorneys who represent Urologix here. The defendant in that action, Dornier Medical Systems, Inc., argued, among other things, that the '004 patent was invalid due to a failure of copendency and presented evidence on this issue at a preliminary injunction hearing. The court did not decide the patent's validity, but did find in addressing Technomed's motion for a preliminary injunction, that Technomed had a reasonable likelihood of successfully defending against the invalidity charge. *Technomed*, slip op. at 6. Soon after, the case settled.

On March 29, 2002, Urologix filed the instant case against Prostalund AB, Prostalund Operations AB, and Circon Corporation, a/k/a ACMI Corporation (collectively, "Prostalund") for infringement of the '004 patent. As discussed above, Prostalund filed a summary judgment motion arguing invalidity due to a failure of copendency. Urologix argued in response that the '004 patent was valid and that, if it was not, I should allow Urologix to petition the PTO to revive the '741 application so as to fix the failure of copendency. In my October 2002 decision, I found that the patent was invalid and declined to put off my decision to permit Urologix to petition the PTO because I found that "Urologix ha[d] known about the copendency problem since at least 1998 when the issue was raised in [the *Technomed* litigation], yet taken no action to remedy it." *Urologix*, 227 F.Supp.2d at 1041.

After my October 2002 decision issued, Urologix filed a PTO petition to revive the '741 application under 37 C.F.R. § 1.137(b) for the specific purpose of correcting the failure of copendency. (R. 143 Ex. 1.) A patent-holder can petition the PTO to revive an abandoned application and, thereby, correct a failure of copendency. *See* 35 U.S.C. § 41(a)(7). However, under 37 C.F.R. § 1.137(b), the entire

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period of delay "from the due date for the reply until the filing of a grantable petition" to revive must be "unintentional" and the petitioner's petition must include a statement to that effect. 37 C.F.R. § 1.137(b)(3). In evaluating these petitions, the PTO "relies upon the applicant's duty of candor and good faith and accepts the statement that 'the entire delay ... was unintentional' without requiring further information in the vast majority of petitions." Manual of Patent Examining Procedure ("MPEP") § 711.03(c)(III)(C) (8th ed.2001).

In its petition, Urologix argued to the PTO that "any abandonment of the '741 application before establishing copendency with the '847 application was unintentional, and therefore within the PTO's discretion to cure." (R. 143 Ex. 1.) In addition, contrary to my October 2002 decision, Urologix stated that "[i]t was not until receipt of the Courts' [sic] October 10, 2002 decision that the need to file this petition was noted." (*Id.*) In a footnote, Urologix mentioned the *Technomed* decision, but said that "[o]n the basis of th[e] decision, there was no need for the Applicants to take any action to address the alleged lack of copendency." (*Id.*) Hence, Urologix maintained before the PTO that the entire period of delay was unintentional because Urologix did not know of the copendency problem until October 2002. (*Id.*)

On November 19, 2002, the PTO granted Urologix's petition to revive. (R. 142 Ex. 2.) The PTO did not address the 1998 *Technomed* decision regarding the lack of copendency or my October 2002 decision, but only discussed the inadvertent failure in 1991 to maintain copendency during prosecution. Armed with this PTO decision, Urologix has returned to me to ask *914 that I vacate my October 2002 order finding the '004 patent invalid.

II. STANDARD FOR RECONSIDERATION

[1][2] The orderly administration of litigation requires that the finality of orders, even interlocutory ones, be reasonably certain. *See Gould, Inc. v. United States*, 67 F.3d 925, 930-31 (Fed.Cir.1995); *Mendenhall v. Barber-Greene Co.*, 26 F.3d 1573, 1582 (Fed.Cir.1994); *Rothner v. City of Chicago*, 929 F.2d 297, 301 (7th Cir.1991). Thus, although the court may reconsider its interlocutory orders at "any time before the entry of judgment," Fed.R.Civ.P. 54(b), under the law of the case doctrine, courts generally should not reopen issues once decided, *Agostini v. Felton*, 521 U.S. 203, 236, 117 S.Ct. 1997, 138 L.Ed.2d 391 (1997); *Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800, 815, 108 S.Ct. 2166, 100 L.Ed.2d 811 (1988) ("[C]ourts should be loathe to [reconsider their prior decisions] in the absence of extraordinary circumstances."); *Creek v. Vill. of Westhaven*, 144 F.3d 441, 446 (7th Cir.1998). "The law of the case doctrine is not to be lightly disregarded. It is based on the salutary and sound public policy that litigation should come to an end." *Rothner*, 929 F.2d at 301. "An exception exists where the court is 'convinced that its prior decision is clearly erroneous and would work a manifest injustice.' " *Agostini*, 521 U.S. at 236, 117 S.Ct. 1997 (quoting *Arizona v. California*, 460 U.S. 605, 618, n. 8, 103 S.Ct. 1382, 75 L.Ed.2d 318 (1983)). However, parties are expected to marshal all their arguments and evidence in opposition to a dispositive motion. *Caisse Nationale de Credit Agricole v. CBI Indus., Inc.*, 90 F.3d 1264, 1270 (7th Cir.1996). The court will view "[b]elated factual or legal attacks ... with great suspicion." *Id.*[FN3]

FN3. I apply the standard articulated by the Seventh Circuit because the standard is a matter of procedure not within the exclusive jurisdiction of the Federal Circuit. *See Genentech, Inc. v. Amgen, Inc.*, 289 F.3d 761, 768 (Fed.Cir.2002) ("On procedural issues not unique to this court's exclusive jurisdiction, this court applies the procedural law of the regional circuit."); *Serrano v. Telular*, 111 F.3d 1578, 1582, 1584-85 (Fed.Cir.1997) (applying law of regional circuit in reviewing a motion for reconsideration). However, I also cite Federal Circuit law, as the standards are substantially the same.

III. DISCUSSION

[3] As discussed, I ruled on ProstaLund's motion for summary judgment and found the '004 patent invalid due to a failure of copendency. This conclusion became the law of the case. Urologix now argues, however, that the later PTO decision corrected the failure of copendency and requires that I vacate my order. I therefore must determine whether the PTO decision makes my October 2002 clearly erroneous and manifestly unjust. I conclude that it does not.

A. Clearly Erroneous

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Clear error is a high standard. The Seventh Circuit has explained that clear error "means more than just maybe or probably wrong; [the error] must ... strike [the court] as wrong with the force of a five-week-old, unrefrigerated dead fish." *Parts & Elec. Motors, Inc. v. Sterling Elec., Inc.*, 866 F.2d 228, 233 (7th Cir.1988); *accord Ginter ex rel. Ginter v. United States*, 740 F.2d 947, 950 (Fed.Cir.1984) ("[A] mere suspicion of error, no matter how well supported, does not warrant reopening an already decided point. Only if we were convinced to a certainty that our prior decision was incorrect would we be warranted in now reexamining it."). Urologix's arguments do not show that my decision meets this standard.

*915 Nothing Urologix has presented casts doubt on the correctness of my decision at the time it issued. The PTO decision does not show that my decision was erroneous at the time. To the contrary, the PTO decision indicates that I was correct in my conclusion that there was a failure to copendency and that, therefore, the '004 patent was invalid.

Rather, Urologix argues that the PTO decision makes my October 2002 decision clearly erroneous now. However, in order for that to be the case, the PTO's revival of the abandoned application must make the '004 patent retroactively valid, not only for purposes of future litigation, but for the purpose of this litigation initiated before the lapse was cured and in which the patent's invalidity has already been determined.

However, it is not clear that the PTO decision has any effect in ongoing litigation filed before the PTO issued its decision. A certificate of correction issued to remedy a failure of copendency, for example, has no effect in a lawsuit filed before the certificate issued. *See, e.g., Southwest Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280, 1294 (Fed.Cir.2000); *see also Adrain v. Hypertech, Inc.*, No. 2:98-CV-37C, 2001 WL 740542, at *3 (D.Utah Apr. 18, 2001). I can find no case addressing the retroactive effect of revival pursuant to 35 U.S.C. § 41(a)(7), and the parties point to none. *See Suntiger, Inc. v. Telebrands Adver., Inc.*, No. Civ.A.97-423-A, 1997 WL 855581, at *4 (E.D.Va. July 11, 1997) (declining to reach the issue). Indeed, Urologix appears to simply assume that the PTO decision to revive has retroactive effect in ongoing litigation. However, this conclusion is not at all apparent.

Furthermore, even if the PTO decision could effect ongoing litigation, it is not clear that such a decision could ever operate *nunc pro tunc* to undermine the prior decision of a federal court. The Supreme Court has said that "[j]udgments, within the powers vested in courts by the Judiciary Article of the Constitution, may not lawfully be revised, overturned, or refused faith and credit by another Department of Government." *Chi. & S. Air Lines, Inc. v. Waterman S.S. Corp.*, 333 U.S. 103, 113, 68 S.Ct. 431, 92 L.Ed. 568 (1948). To be sure, my October 2002 decision did not result in a judgment. Nonetheless, it conclusively resolved an issue that was within my power to resolve. Thus, it is not clear that the PTO decision could have any effect on my decision's validity.

In sum, Urologix has presented no argument that indicates that my October 2002 decision is clearly erroneous. However, even if I were to conclude otherwise, Urologix's motion would fail because I do not find that my decision works a manifest injustice.

B. Manifestly Unjust

Urologix's present circumstances are the result of the litigation strategy it chose; thus, my decision works no manifest injustice. As I previously determined, Urologix has known, since at least 1998 when the issue was raised in the *Technomed* litigation, that its patent may have failed to satisfy the copendency requirement of the patent statute. *See* 35 U.S.C. § 120. Although Judge Clevert held that Urologix had a reasonable likelihood of successfully defending against the invalidity charge, litigation of the issue put Urologix on notice that copendency might be a problem. After conclusion of the *Technomed* litigation in 1998, however, Urologix chose not to seek a ruling from the PTO regarding the copendency issue. The issue arose again in the present litigation when ProstaLund moved for summary judgment in May 2002. However, rather than asking the PTO to resolve the issue while the motion was pending, Urologix made a decision to *916 continue to defend the patent's validity. The parties engaged in discovery on the issue, prepared briefs and presented testimony. Then I decided the issue. Only when its strategy resulted in an unfavorable decision did Urologix petition the PTO to cure the problem. Urologix's much-belated attempt to resolve a problem it had known about for at least four years does not make my decision unjust. *See Baumer v. United States*, 685 F.2d 1318, 1321 (11th Cir.1982) (declining to revisit the law of the case where party's litigation strategy led to the challenged result); *see also Caisse Nationale*, 90 F.3d at 1270 (7th Cir.1996) (reaffirming that reconsideration "is not an

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appropriate forum for . . arguing matters that could have been heard during the pendency of the previous motion"); *Smith Int'l, Inc. v. Hughes Tool Co.*, 759 F.2d 1572, 1578-79 (Fed.Cir.1985) (holding that district court acted properly in declining to consider evidence that could have been presented when issue was originally pending).

In addition, in persuading the PTO to revive the lapsed application, Urologix was less than fully candid. In its petition to the PTO, Urologix presented an incomplete picture of the circumstances surrounding the petition to revive. Urologix averred, as required for revival, that the entire period of delay, from the abandonment until the filing of the petition, was unintentional and that "until this Court issued its October 10[, 2002] Order, Urologix had every reason to believe that it had a *valid patent*." (R. 152 at 9.) In addition, to demonstrate to the PTO that the delay had been unintentional, Urologix relied on arguments that I had expressly rejected without indicating that I had done so. Urologix failed to mention that I had determined that it had been aware of the copendency issue since 1998, yet chose not to file a petition to revive. Moreover, merely attaching a copy of my decision containing statements contrary to those in the petition was insufficient because, under the MPEP, Urologix's statements to the PTO were presumed true. *See* MPEP § 711.03(c)(III)(C) (8th ed.2001); *see also id.* § 2001.06(c) (stating that an applicant for patent or reissue is under a duty to bring to the attention of the PTO "any assertion that is made during litigation which is contradictory to assertions made to the examiner."). The PTO's revival of the application based on this incomplete picture of the record does not make my October 2002 decision manifestly unjust. Thus, the law of the case will stand.[FN4]

FN4. Urologix also has moved this court to vacate its October 16, 2002 Order denying Urologix's motion for preliminary injunction based on alleged infringement of the '004 patent. As I have not disturbed the October 10, 2002 order, I also do not disturb the October 16, 2002 order.
I note that the Federal Circuit in reviewing motions for reconsideration has also stated that revision is appropriate (1) where a change in the controlling law would now require that the court reach a different result and (2) where the moving party presents new evidence that could not have been presented during the original pendency of the issue. *See Gould*, 67 F.3d at 930; *Smith Int'l*, 759 F.2d at 1578-79. Urologix has not demonstrated that either of these exceptions applies. First, the controlling law has not changed. Second, as discussed above, Urologix could have petitioned the PTO to correct the failure of copendency before I ruled on the motion for invalidity. Thus, the PTO decision does not constitute "new evidence" justifying reconsideration of my decision.

IV. CONCLUSION

THEREFORE, IT IS ORDERED that plaintiff's motion to vacate the court's decision and order dated October 10, 2002 is **DENIED.**

IT IS FURTHER ORDERED that plaintiff's motion to file a reply brief in support of its motion to vacate is **GRANTED***917 and that defendants' motion to file a surreply brief is **GRANTED.**

E.D.Wis.,2003.
Urologix, Inc. v. Prostalund AB
256 F.Supp.2d 911

Briefs and Other Related Documents (Back to top)

- 2:02cv00318 (Docket) (Mar. 29, 2002)

END OF DOCUMENT

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Exhibit B

Public Law 97-247
97th Congress

An Act

To authorize appropriations to the Patent and Trademark Office in the Department of Commerce, and for other purposes.

Aug. 27, 1982
[H.R. 6260]

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That there is authorized to be appropriated for the payment of salaries and necessary expenses of the Patent and Trademark Office to become available for fiscal year 1983, $76,000,000, and in fiscal years 1984 and 1985 such sums as may be necessary as well as such additional or supplemental amounts as may be necessary, for increases in salary, pay, retirement, or other employee benefits authorized by law. Funds available under this section shall be used to reduce by 50 per centum the payment of fees under section 41 (a) and (b) of title 35, United States Code, by independent inventors and nonprofit organizations as defined in regulations established by the Commissioner of Patents and Trademarks, and by small business concerns as defined in section 3 of the Small Business Act and by regulations established by the Small Business Administration. When so specified and to the extent provided in an appropriation Act, any amount appropriated pursuant to this section and, in addition, such fees as shall be collected pursuant to title 35, United States Code, and the Trademark Act of 1946, as amended (15 U.S.C. 1051 et seq.), may remain available without fiscal year limitation.

Patent and Trademark Office. Appropriation authorization.

15 USC 632.

SEC 2. Notwithstanding any other provision of law, there is authorized to be appropriated for the payment of salaries and expenses of the Patent and Trademark Office, $121,461,000 for the fiscal year ending September 30, 1982, and such additional or supplemental amounts as may be necessary for increases in salary, pay, retirement, or other employee benefits authorized by law.

SEC 3. (a) Section 41(a) of title 35, United States Code, is amended to read as follows:

"(a) The Commissioner shall charge the following fees:

Fees.

"1. On filing each application for an original patent, except in design or plant cases, $300; in addition, on filing or on presentation at any other time, $30 for each claim in independent form which is in excess of three, $10 for each claim (whether independent or dependent) which is in excess of twenty, and $100 for each application containing a multiple dependent claim. For the purpose of computing fees, a multiple dependent claim as referred to in section 112 of this title or any claim depending therefrom shall be considered as separate dependent claims in accordance with the number of claims to which reference is made. Errors in payment of the additional fees may be rectified in accordance with regulations of the Commissioner.

35 USC 112.

"2. For issuing each original or reissue patent, except in design or plant cases, $500.

"3. In design and plant cases:

"a. On filing each design application, $125.

"b. On filing each plant application, $200.
"c. On issuing each design patent, $175.
"d. On issuing each plant patent, $250.

"4. On filing each application for the reissue of a patent, $300; in addition, on filing or on presentation at any other time, $30 for each claim in independent form which is in excess of the number of independent claims of the original patent, and $10 for each claim (whether independent or dependent) which is in excess of twenty and also in excess of the number of claims of the original patent. Errors in payment of the additional fees may be rectified in accordance with regulations of the Commissioner.

"5. On filing each disclaimer, $50.

"6. On filing an appeal from the examiner to the Board of Appeals, $115; in addition, on filing a brief in support of the appeal, $115, and on requesting an oral hearing before the Board of Appeals, $100.

"7. On filing each petition for the revival of an unintentionally abandoned application for a patent or for the unintentionally delayed payment of the fee for issuing each patent, $500, unless the petition is filed under sections 133 or 151 of this title, in which case the fee shall be $50.

35 USC 133, 151.

"8. For petitions for one-month extensions of time to take actions required by the Commissioner in an application:
"a. On filing a first petition, $50.
"b. On filing a second petition, $100.
"c. On filing a third or subsequent petition, $200.".

(b) Section 41(b) of title 35, United States Code, is amended to read as follows:

Maintenance fees.

"(b) The Commissioner shall charge the following fees for maintaining a patent in force:
"1. Three years and six months after grant, $400.
"2. Seven years and six months after grant, $800.
"3. Eleven years and six months after grant, $1,200.

Expiration.

Unless payment of the applicable maintenance fee is received in the Patent and Trademark Office on or before the date the fee is due or within a grace period of six months thereafter, the patent will expire as of the end of such grace period.

Surcharge.

The Commissioner may require the payment of a surcharge as a condition of accepting within such six-month grace period the late payment of an applicable maintenance fee. No fee will be established for maintaining a design or plant patent in force.".

(c) Section 41(c) of title 35, United States Code, is amended to read as follows:

Maintenance fee, delayed payment.

"(c)(1) The Commissioner may accept the payment of any maintenance fee required by subsection (b) of this section after the six-month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable.

Surcharge.

The Commissioner may require the payment of a surcharge as a condition of accepting payment of any maintenance fee after the six-month grace period. If the Commissioner accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.

"(2) No patent, the term of which has been maintained as a result of the acceptance of a payment of a maintenance fee under this subsection, shall abridge or affect the right of any person or his successors in business who made, purchased or used after the six-month grace period but prior to the acceptance of a maintenance fee

under this subsection anything protected by the patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased, or used. The court before which such matter is in question may provide for the continued manufacture, use or sale of the thing made, purchased, or used as specified, or for the manufacture use or sale of which substantial preparation was made after the six-month grace period but before the acceptance of a maintenance fee under this subsection, and it may also provide for the continued practice of any process, practiced, or for the practice of which substantial preparation was made, after the six-month grace period but prior to the acceptance of a maintenance fee under this subsection, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced after the six-month grace period but before the acceptance of a maintenance fee under the subsection.".

(d) Section 41(d) of title 35, United States Code, is amended to read as follows:

"(d) The Commissioner will establish fees for all other processing, services, or materials related to patents not specified above to recover the estimated average cost to the Office of such processing, services, or materials. The yearly fee for providing a library specified in section 13 of this title with uncertified printed copies of the specifications and drawings for all patents issued in that year will be $50." Fees. 35 USC 13.

(e) Section 41(f) of title 35, United States Code, is amended to read as follows: Adjusted fees.

"(f) The fees established in subsections (a) and (b) of this section may be adjusted by the Commissioner on October 1, 1985, and every third year thereafter, to reflect any fluctuations occurring during the previous three years in the Consumer Price Index, as determined by the Secretary of Labor. Changes of less than 1 per centum may be ignored.".

(f) Subsection (a) of section 31 of the Trademark Act of 1946, as amended (15 U.S.C. 1113), is amended by deleting "Fees will be set and adjusted by the Commissioner to recover in aggregate 50 per centum of the estimated average cost to the Office of such processing. Fees for all other services or materials related to trademarks and other marks will recover the estimated average cost to the Office of performing the service or furnishing the material.".

(g) Section 42(c) of title 35, United States Code, is amended by adding the following sentence at the end thereof: "Fees available to the Commissioner under section 31 of the Trademark Act of 1946, as amended (15 U.S.C. 1113), shall be used exclusively for the processing of trademark registrations and for other services and materials related to trademarks.".

SEC. 4. Section 3(a) of title 35, United States Code is amended (1) by deleting the phrase "not more than fifteen"; and (2) by inserting the phrase "appointed under section 7 of this title" immediately after the phrase "examiners-in-chief".

SEC. 5. Section 111 of title 35, United States Code, is amended to read as follows:

"SEC. 111. Application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application Applications. 35 USC 112. 35 USC 113. 35 USC 115.

must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Commissioner. Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Commissioner that the delay in submitting the fee and oath was unavoidable. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.".

Filing date.

SEC. 6. (a) Section 116 of title 35, United States Code, is amended (1) by deleting the phrase "Joint inventors" from the title and inserting in its place "Inventors"; and (2) in the third paragraph, by deleting the phrase "a person is joined in an application for patent as joint inventor through error, or a joint inventor is not included in an application through error" and inserting in its place the phrase "through error a person is named in an application for patent as the inventor, or through error an inventor is not named in an application".

(b) Section 256 of title 35, United States Code, is amended to read as follows:

"§ 256. Correction of named inventor

"Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

"The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Commissioner shall issue a certificate accordingly.".

SEC. 7. Section 6 of title 35, United States Code, is amended by deleting paragraph (d) thereof.

SEC. 8. (a) Section 8(a) of the Trademark Act of 1946, as amended (15 U.S.C. 1058(a)), is amended (1) by deleting the word "still"; and (2) by inserting the phrase "in commerce" immediately after the word "use".

(b) Section 8(b) of the Trademark Act of 1946, as amended (15 U.S.C. 1058(b)), is amended (1) by deleting the word "still"; and (2) by inserting the phrase "in commerce" immediately after the word "use".

SEC. 9. (a) Section 13 of the Trademark Act of 1946, as amended (15 U.S.C. 1063), is amended (1) by deleting the phrase "a verified" and inserting in its place the word "an"; (2) by adding the phrase "when requested prior to the expiration of an extension" immediately after the word "cause"; and (3) by deleting the fourth sentence.

(b) Section 14 of the Trademark Act of 1946, as amended (15 U.S.C. 1064), is amended by deleting the word "verified".

SEC. 10. Section 15 of the Trademark Act of 1946, as amended (15 U.S.C. 1065), is amended by deleting the phrase "the publication" and inserting in its place the word "registration".

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SEC. 11. The first sentence of section 16 of the Trademark Act of 1946, as amended (15 U.S.C. 1066), is amended to read as follows: "Upon petition showing extraordinary circumstances, the Commissioner may declare that an interference exists when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when applied to the goods or when used in connection with the services of the applicant to cause confusion or mistake or to deceive.".

SEC. 12. Section 21 of title 35, United States Code, is amended—

(1) by deleting the phrase "Day for taking action falling on Saturday, Sunday, or holiday" from the title and inserting in its place the phrase "Filing date and day for taking action";

(2) by inserting the following as subsection (a):

"(a) The Commissioner may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Commissioner."; Filing date.

(3) by designating the existing paragraph as subsection (b); and

(4) by inserting the word "federal" in subsection (b), as designated above, immediately after the word "a".

SEC. 13. Section 6(a) of title 35, United States Code, is amended (1) by deleting the word "and", third occurrence, and inserting in its place a comma; (2) by inserting the phrase ", or exchanges of items or services" immediately after the word "programs"; and (3) by inserting the phrase "or the administration of the Patent and Trademark Office" immediately after the word "law", second occurrence.

SEC. 14. (a) Section 115 of title 35, United States Code, is amended by (1) deleting the phrase "shall be" and inserting in its place the word "is"; and (2) inserting the following immediately after the phrase "United States", third occurrence: ", or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States".

(b) Section 261 of title 35, United States Code, is amended, in the third paragraph, by inserting the following immediately after the phrase "United States", third occurrence: ", or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States".

(c) Section 11 of the Trademark Act of 1946, as amended (15 U.S.C. 1061), is amended by (1) deleting the phrase "shall be", first occurrence, and inserting in its place the word "is"; and (2) inserting the following immediately after the phrase "United States", third occurrence: ", or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States".

SEC. 15. Section 13 of title 35, United States Code, is amended by deleting "(a) 9" and inserting in its place "(d)".

SEC. 16. Section 173 of title 35, United States Code, is amended to read as follows: "Patents for designs shall be granted for the term of fourteen years."

Effective dates.
35 USC 41 note.

SEC. 17. (a) Sections 1, 2, 4, 7, and 13 through 15 of this Act shall take effect on the date of enactment of this Act. Sections 8 and 16 of this Act shall take effect on October 1, 1982. The maintenance fees provided for in section 3(b) of this Act shall not apply to patents applied for prior to the date of enactment of this Act. Each patent applied for on or after the date of enactment of this Act shall be subject to the maintenance fees established pursuant to section 3(b) of this Act or to maintenance fees hereafter established by law, as to the amounts paid and the number and timing of the payments.

(b)(1) Title 35, United States Code, is amended by inserting after section 293 the following new section of chapter 29:

35 USC 294.

"§ 294. Voluntary arbitration

"(a) A contract involving a patent or any right under a patent may contain a provision requiring arbitration of any dispute relating to patent validity or infringement arising under the contract. In the absence of such a provision, the parties to an existing patent validity or infringement dispute may agree in writing to settle such dispute by arbitration. Any such provision or agreement shall be valid, irrevocable, and enforceable, except for any grounds that exist at law or in equity for revocation of a contract.

Awards.
9 USC 1 *et seq.*

"(b) Arbitration of such disputes, awards by arbitrators and confirmation of awards shall be governed by title 9, United States Code, to the extent such title is not inconsistent with this section. In any such arbitration proceeding, the defenses provided for under section 282 of this title shall be considered by the arbitrator if raised by any party to the proceeding.

35 USC 282.

"(c) An award by an arbitrator shall be final and binding between the parties to the arbitration but shall have no force or effect on any other person. The parties to an arbitration may agree that in the event a patent which is the subject matter of an award is subsequently determined to be invalid or unenforceable in a judgment rendered by a court to competent jurisdiction from which no appeal can or has been taken, such award may be modified by any court of competent jurisdiction upon application by any party to the arbitration. Any such modification shall govern the rights and obligations between such parties from the date of such modification.

Modification.

Notices.

"(d) When an award is made by an arbitrator, the patentee, his assignee or licensee shall give notice thereof in writing to the Commissioner. There shall be a separate notice prepared for each patent involved in such proceeding. Such notice shall set forth the names and addresses of the parties, the name of the inventor, and the name of the patent owner, shall designate the number of the patent, and shall contain a copy of the award. If an award is modified by a court, the party requesting such modification shall give notice of such modification to the Commissioner. The Commissioner shall, upon receipt of either notice, enter the same in the record of the prosecution of such patent. If the required notice is not filed with the Commissioner, any party to the proceeding may provide such notice to the Commissioner.

Modification.

"(e) The award shall be unenforceable until the notice required by subsection (d) is received by the Commissioner.".

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(2) The analysis for chapter 29 of title 35 of the United States Code is amended by adding at the end the following:

"294. Voluntary arbitration.".

(c) Sections 5, 6, 8 through 12, and 17(b) of this Act shall take effect six months after enactment. 35 USC 294 note.

Approved August 27, 1982.

LEGISLATIVE HISTORY—H.R. 6260:

HOUSE REPORT No. 97-542 (Comm. on the Judiciary).
CONGRESSIONAL RECORD, Vol. 128 (1982):
June 8, considered and passed House.
Aug. 12, considered and passed Senate.
WEEKLY COMPILATION OF PRESIDENTIAL DOCUMENTS, Vol. 18, No. 36 (1982):
Aug. 28, Presidential statement.